

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTORS: Vinny Formale, Marcus Koestler, Jamie Randolph,
Geetika Shinde, Vance Taylor, GERAL TIESKOETTER, and Lagray Wells

APPLICATION NO. 10/083,170 Confirmation No. 5144

FILED: February 26, 2002 Examiner: Ojo O. Oyeibisi

CASE NO. RSW920010215US1 Group Art Unit: 3694

TITLE: METHOD, SYSTEM, AND GRAPHIC USER INTERFACE FOR
AUTOMATED ASSET MANAGEMENT

FILED ELECTRONICALLY ON NOVEMBER 18, 2008

MAIL STOP APPEAL BRIEF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Board of Patent Appeals and Interferences

REQUEST TO MAINTAIN APPEAL/REPLY BRIEF

This Request to Maintain Appeal/Reply Brief is filed in response to the Examiner's Answer, mailed September 18, 2008. Applicant requests that the appeal be maintained. The new grounds of rejection are addressed in the following Reply Brief. Applicant believes that no fee is associated with the filing of this brief, but authorizes the Commissioner to charge any fees to Deposit Account No. 09-0461.

November 18, 2008

1. STATUS OF CLAIMS

- A. Claims canceled: none
- B. Claims withdrawn from consideration but not canceled: None
- C. Claims pending: 1-30
- D. Claims allowed: none
- E. Claims rejected: 1-30
- F. Claims appealed: 1-30

Appealed claims 1-30 as currently pending were submitted in the Claims Appendix attached to Applicant's Resubmission of Appeal Brief filed on June 23, 2008.

November 18, 2008

2. **GROUND S OF REJECTION TO BE REVIEWED ON APPEAL**

Appellants request the Board to review the following rejections:

- A. Rejection of claims 1-30 under 35 U.S.C. §102(b) as being anticipated by Chapter 7 (Disposition Sections 7.1, <http://www.stanford.edu/dept/UPA/chapter%207.html>) (referred to herein as "Chapter 7"). (This rejection was addressed in Applicant's Appeal Brief, filed on March 31, 2008 and resubmitted on June 23, 2008.)
- B. Rejection of claims 2, 3, and 6-10 under 35 U.S.C. §101 as being directed to non-statutory subject matter, **newly presented in the Examiner's Answer**; and
- C. Rejection of claims 11-20 under 35 U.S.C. §112, second paragraph, as being indefinite, **newly presented in the Examiner's Answer**.

November 18, 2008

3. ARGUMENT

A. Rejection of claims 1-30 under 35 U.S.C. §102(b) as being anticipated by Chapter 7

For the Board's convenience, applicant presents again the argument regarding the §102(b) rejection, originally submitted with the Appeal Brief.

The Examiner Has Not Established a *Prima Facie* Case of Anticipation

As set forth in the MPEP:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."
MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The Examiner Has Not Established a *prima facie* Case of Anticipation

As noted above, the present claimed invention includes a central server that automatically performs the steps required to manage an organization's disposal of assets. The central server automatically obtains all required approvals for said asset disposition request, automatically effects said asset disposition request, and automatically modifies said data to reflect said effected disposition request. As a result, employees of the organization are not required to spend time researching information about an asset in order to know what the proper procedure is for disposing of that asset. Additionally, the organization's asset management data is updated in real time to reflect changes in the status of its assets.

In contrast to the present claimed invention, Chapter 7 does not control its asset management through a central server. Rather, Chapter 7 gives directions to the several different

November 18, 2008

employees of several different departments in an organization regarding the manual steps that must be taken in order to dispose of the organization's assets. The document informs the individual employees what specific, manual steps they are to carry out in the procedure. In the procedures listed in Chapter 7, an employee is directed to dispose of an asset by submitting an on-line disposal request (DR). Once an employee submits the on-line DR, Chapter 7 lists the information that various employees and departments in the organization must gather about the asset and lists the steps that employees must perform in order to complete the asset disposal procedure. All the steps listed in Chapter 7 are carried out manually by multiple employees of multiple departments in the organization. Specifically, the table beginning on page 11, line 19 lists nine steps of the procedure that must be manually performed by designated employees/departments of the organization. For example, in step 3 on page 11, lines 25-27, a person in the Property Management Office (PMO) reviews and approves a DR and then routes the DR to a person in the Surplus Property Sales division. In step 8 on page 12, lines 20-22, a person in the PMO updates the organization's records to reflect the disposal of the asset.

In the Response to Arguments section on page 7-8 of the final Office Action, the Examiner asserts that simply because the Chapter 7 document includes the word 'online', the procedure disclosed in the document is fully automated at a central server. The Examiner states that a central server is nothing but a computer dedicated to a certain purpose. However, in the same paragraph, the Examiner states that Chapter 7 comprises multiple computers, servers, databases, circuits/dedicated lines and routers – all the equipment needed for online transactions.

November 18, 2008

The Examiner's position appears to contradict itself because, clearly, multiple computers and servers are not the same a single central server that performs all the steps of the present invention.

The Examiner states that page 5, line 16 of Chapter 7 discloses a central server configured to access data and software systems of said organization. However, nowhere does Chapter 7 contain any type of disclosure about any type of server. Page 5, line 16 on Chapter 7 simply discloses that disposal requests can be submitted online. The Examiner appears to be basing his entire argument on the word 'online' that appears on page 5, line 16 in the Chapter 7 document, contending that this single word implies not only that the entire procedure of Chapter 7 is fully automated but that it is performed by a central server. This is incorrect. The word 'online' does not disclose or suggest the automatic performance of the steps at a central server, as in the present invention. Chapter 7 clearly states, in the table on pages 11-12 of for example, that the various steps listed in the document are performed by several different people in several different departments in an organization. The word 'online' merely implies that a computer network is involved in some facet of the Chapter 7 procedure, nothing more. Nothing in Chapter 7 teaches or suggests that a central server automatically obtains all required approvals for said asset disposition request, automatically effects said asset disposition request, and automatically modifies said data to reflect said effected disposition request as in the claimed invention.

Similarly, the Examiner states that page 5, line 27 of Chapter 7 discloses identifying one or more of said assets for management and submitting an asset disposition request to said central

November 18, 2008

server. However, the five word sentence pointed to by the Examiner (“identify items which are excess”) makes no mention of any type of server and the identification referred to in that line is only a classification of whether an asset is “excess” or not. Nothing in the cited passage or anywhere else in Chapter 7 discloses that an asset disposition request is submitted to a central server that automatically performs the disposition and updates the organization’s data, as recited in the independent claims of the present invention.

The Examiner further states that page 12, step 8 of Chapter 7 discloses automatically modifying said data to reflect said effected disposition request at the central server. However, the cited passage specifically discloses that it is the responsibility of a person in the Property Management Office (PMO) to manually update the records with the sales/scrap data per Surplus Property Sales (SPS) disposition report. A person in one division of the organization (PMO) must manually update the organization’s data based on information contained in a monthly report generated by another division of the organization (SPS). This type of manual updating of the organization’s records by different departments disclosed in Chapter 7 (and the delays and potential errors associated with it) is precisely the problem in the prior art that the present invention solves.

In a telephone interview with the Examiner on December 13, 2007, the Examiner further stated that In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) supported the position that the present claimed invention, in which the steps are performed automatically at a central server, is not patentable. However, In re Venner holds only that it is not invention to

November 18, 2008

merely provide mechanical or automatic means to replace manual activity which accomplished the same result. The present invention does not merely replace manual activity with mechanical activity which accomplishes the same result. Rather, the present invention also provides a different structure that automatically performs, at a central server, all the steps of obtaining automated approval for an asset management process, consolidating the process to a single entity and dramatically decreasing both the time, expense and effort required for asset disposal.

Unlike Chapter 7, the present system allows users to obtain automated approval for an asset management process when they initiate the process. The steps of the process are carried out at a central server. The system also ensures that assets are written off the books as soon as they have been disposed of. Further, a listing of surplus assets that can be utilized by other employees in the company is created and made available to the employees, and employees are able to transfer assets to other employees, and update assets as appropriate. The process of Chapter 7 provides none of these benefits.

In summary, although Chapter 7 discloses using computers for on-line form submission and email to send messages from one employee to another in order to perform isolated steps of the asset disposal process outlined in the document, nowhere does Chapter 7 disclose a central server or any type of computer that will automatically carry out the process of asset management and the updating of organization records as in the claimed invention. Accordingly, each of the independent claims (Claims 1, 11 and 21), and all claims depending therefrom, patentably define over Chapter 7 and are in condition for allowance.

November 18, 2008

B. New Grounds: Rejection of claims 2, 3, and 6-10 under 35 U.S.C. §101

In the Examiner's Answer, the Examiner raised a new ground for rejection, rejecting claims 2, 3, and 6-10 under 35 U.S.C. §101. The Examiner asserts that these claims do not recite a machine to perform the steps of the claim and thus do not meet the statutory requirements of patentability. Applicant respectfully traverses this rejection. As is clear from reading claim 1, and as admitted by the Examiner by the omission of claim 1 from the §101 rejection, claim 1 clearly includes recitation of a machine to carry out the various steps of the claimed method. Claims 2, 3, and 6-10 each depend from claim 1 and thus these claims also recite the same structure of claim 1. The fact that an isolated dependent claim qualifies an element of claim 1 (e.g., by narrowing claim 1 to recite that the automatic modifying step performed at the central server comprises modifying financial data of the organization, or that the financial data being automatically modified at the central server comprises at least tax records and balance sheets) does not take away from the fact that the claims include the structural/machine elements claimed in the independent claim and is thus statutory. Each of the claims rejected by the Examiner on §101 grounds include the structural/machine limitations of claim 1; accordingly, each meets the requirements of §101. The Board is respectfully requested to overrule the Examiner's new ground of rejection, that is, the rejection under 35 U.S.C. §101.

November 18, 2008

C. New Grounds: Rejection of claims 11-20 under 35 U.S.C. §112, second paragraph

In the Examiner's Answer, the Examiner raised a second new ground for rejection, rejecting claims 11-20 under 35 USC §112. Applicant agrees with the Examiner's general statement of the law regarding the correct manner to construe means-plus-function claims, which includes looking to the specification to identify the means disclosed to perform the claimed functions. Applicant further agrees that IF the Applicant had merely recited functions to be performed in the claims, and disclosed that the functions could all be performed by a microprocessor, without identifying an "algorithm" to be processed by the microprocessor, the claim might not meet the requirements of 35 U.S.C. §112. However, in this particular application, the algorithm to be executed by the processor is clearly defined by the flowchart (Fig. 11) and the description thereof. This flowchart gives specific recitation of the steps to be performed by the disclosed processor to achieve the claimed invention. Applicant is claiming the processing of the specific steps identified in the algorithm provided in flowchart form, which is the most well-known method of portraying an algorithm in a patent disclosure. In other words, Applicant respectfully disagrees with the Examiner's assertion that no algorithm is disclosed and directs the Board to the flowchart and descriptions in the specification as evidence of the claimed algorithm. The Board is respectfully requested to overrule the Examiner's new ground of rejection under 35 U.S.C. §112.

4. CONCLUSION

For the foregoing reasons applicants respectfully request this Board to overrule the Examiner's rejections and allow Claims 1-30.

Respectfully submitted,

November 18, 2008

Date

/Mark D. Simpson/

Mark D. Simpson

Registration No. 32942

SAUL EWING LLP

Centre Square West

1500 Market Street, 38th Floor

Philadelphia, PA 19102-2189

Telephone: 215 972 7880

Facsimile: 215 972 4169

Email: MSimpson@saul.com